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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/313,278 05/18/99 GOLDENBERG

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EXAMINER

TM02/0910

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RIMELL, S

ART UNIT

PAPER NUMBER

2166

DATE MAILED:

09/10/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/313,278

Applicant(s)

GOLDENBERG, DAVID M.

Examiner

Sam Rimell

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 29-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27, 29-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

SAM RIMELL  
PRIMARY EXAMINER  
AU 2166

Art Unit: 2166

Claims 14-27 and 30-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*at least one of*  
Claim 14: The phrase "~~one or more~~ of medical, veterinary, or health care information" is indefinite.

Claim 15: The phrase "related to practice guidelines of the inquirer's geographic region".

*at least one of*  
Claim 30: The phrase "~~one or more~~ of medical, veterinary or other health care information" is indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-17, 19-24 and 29-30 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Douglas et al. ('688).

Douglas et al. discloses a processing device which is configured to provide multiple levels of service to a user. At a first level of service, a user can perform research on the system website and download data and research articles containing medical information (col. 14, lines 54-57 and col. 16 lines 21-38). At a second level of service, the user can interact with a group therapist using on-line teleconferencing capabilities (col. 12, lines 8-22). At a third level of service, a user can be monitored for alarm conditions, and upon triggering of the alarm conditions, can be placed into electronic contact with the physician (col. 10, lines 17-31).

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Art Unit: 2166

The processing device can use the alarm feature to distinguish between a need for additional information and a need for contact with a physician (col. 10, lines 17-31).

The system involves the interaction of a patient with at least two medical professionals: A medical doctor and a group therapist who monitors the on-line group therapy sessions.

The processing device receives an image of the patient and transmits to others during the group therapy sessions.

The patients who interact with the system have access to libraries of research studies (col. 16 line 34).

The patients who interact with the system receive medical treatment in the form of group psychotherapy.

The processing device monitors the status and progress of the patient by use of a journal function (FIG. 12).

The processing device has a weighing function in the form of a programmed alarm system, which weighs responses from a user and decides whether those responses are compliant or non-compliant with desired pre-set goals (col. 10 lines 17-31).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. ('688).

Art Unit: 2166

The system of Douglas et al. ('688) allows a user to access a physician but does not specifically allow a user to select from a listing of different physicians. Examiner takes Official Notice that it is well known in the art of insurance plans to produce listings of approved physicians and provide this information in various media, such as in booklets, telephonic referral services and on-line via a network. It would have been obvious to one of ordinary skill in the art to modify Douglas et al. to utilize a physician referral service, either on-line, or by providing phone number so as to permit telephonic access to such data, as is well known in the art to permit patient access to insurance approved physicians.

Claims 14, 20, 25-27, 30 and 32-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown ('563).

Brown ('563) discloses a system that allows a patient to interact with a physician via a wide area network or the Internet. The system has a first level of service where the system can direct a series of questions to the patient (FIG. 16) or, on a second level, receive measured data such as blood glucose level, blood pressure, pulse and temperature( col. 11, line 28 and col. 11, lines 52-57).

#### Remarks

With respect to the rejection of claims 14-27 and 30-32 under 35 USC 112, second paragraph, applicant's amendments have overcome some, but not all of the rejections applied. In particular, the use of the phrase "one or more of medical, veterinary or health care information" is so broad that it is maintained to be indefinite. Not only is this overall statement unreasonably broad, but each of the individual categories of "medical information", "veterinary information" and "healthcare information" are so broad that they overlap each other.

Art Unit: 2166

Claims 1-7, 19-24, 28-30 and 37 have been rejected under 35 USC 102(e) as being anticipated by Douglas et al. ('688). Claims 18-31 were rejected under 35 USC 103(a) as being obvious in view of Douglas et al. Claims 14, 20, 25-27, 30 and 32-36 were rejected under 35 USC 102(e) as being anticipated by Brown ('563).

Applicant argues that claim 1 contains a recitation calling for the user to have "progressively greater degrees of interaction at respective levels of service". Claims 14 and 29 have been amended to recite the same feature. Applicant argues that neither Douglas nor Brown teach such a limitation.

This argument is incorrect. In the Douglas et al. system, the levels of user interaction progress from simple information gathering to invasive therapeutic intervention. Similarly, in the Brown reference, user interaction progresses from interactive questions at one level to invasive therapeutic intervention at the next level.

Examiner does not find that claim language calling for a progression in level of user interaction distinguishes in any way from the claims at issue. If anything, the references to Douglas et al. and Brown suggest this exact feature.

Applicant further argues that claims 30 recites a "similar feature", presumably the feature of having progressively greater levels of user interaction at respective levels of service". However, claim 30 does not appear to contain any such language, or any similar language.

With respect to claim 33, applicant argues that Brown does not disclose "a treatment device". However, the term "treatment device" is generic and may encompass other monitoring devices, or any system that assists in the monitoring functions.

With respect to claim 36, applicant argues that Brown does not disclose an implanted controlled release reservoir. However, claim 36 is a Markush type claim that presents several different alternative limitations. Claim 36 is not necessarily limited to the usage of a controlled release reservoir. Furthermore, in order to demonstrate that a Markush type claim is patentable (claim 36 is a Markush type claim), applicant must demonstrate that the prior art does not read on any one of the claimed alternatives, since the Examiner may reject the claim if the prior art anticipates any one of the alternatives. In the present amendment, applicant does not present such evidence.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Application/Control Number: 09/313,278

Page 7

Art Unit: 2166

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

A handwritten signature in black ink, appearing to read 'S. Rimell', written in a cursive style.

Sam Rimell  
Primary Examiner  
Art Unit 2166